

REMARKS

Claims 1-45 are pending in this application.

The Examiner has made of record the restriction requirement and Applicants' election to prosecute the invention of Group I, claims 1-29. The Examiner requires affirmation of the election.

Applicants hereby affirm the election of Group I, claims 21-29.

The Examiner sets forth the following two anticipation rejections.

- (1) Claims 1, 10, 12-13, 16, 18, and 27-29 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,776,810 to Cherian et al.
- (2) Claims 1, 6-12, 16, 18, 23-26, and 27-29 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0173221 to Li et al.

The Examiner takes the position that Cherian et al and Li et al disclose all the features of the various claims to which they have been applied.

Applicants traverse both rejections.

Claim 1, from which all claims variously depend, recites "a compound having three or more azole moieties...". The description in the specification beginning at page 11, line 8 indicates that compounds having three or more azole moieties in its molecule can be produced through a variety of methods, including various polymerization reactions. The advantages of including a three or more azole moiety compound are described, for example, beginning at page 13, lines 6-24.

In contrast, neither Cherian et al nor Li et al disclose a compound having three or more azole moieties.

The Examiner appears to have misunderstood the claimed compound as being met by, for example, the disclosure at col. 7, lines 10-22 of Cherian et al where the heterocyclic ring is said to contain at least one nitrogen atom, for example, an azole compound, preferably a triazole or benzotriazole.

Similarly, the Abstract and paragraphs [0053]-[0056] of Li et al are cited by the Examiner as disclosing corrosion inhibitors which include any of various conventional organic compounds containing an azole group, such as benzotriazole, mercaptobenzotriazole, or 5-methyl-1-benzotriazole.

A benzotriazole such as in Cherian et al and Li et al is a compound that contains a single azole moiety, in which the azole moiety contains three nitrogen atoms. It is not a compound that contains three azole moieties. An azole moiety, by definition, contains a 5-membered nitrogen heterocyclic ring that contains at least one other noncarbon atom of nitrogen, sulfur or oxygen.

Since Cherian et al and Li et al do not disclose a compound having three or more azole moieties, they do not anticipate the present claims.

In view of the above, Applicants request withdrawal of the anticipation rejections.

The Examiner sets forth the following seven obviousness rejections, which Applicants have numbered as (3) to (9).

- (3) Claims 5, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al.
- (4) Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Li et al as applied to claim 1 above, and further in view of U.S. Patent No. 6,491,837 to Liu et al.

- (5) Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Li et al as applied to claim 1 above, and further in view of U.S. Patent No. 5,976,414 to Bedford et al.
- (6) Claims 14-15 and 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Li et al as applied to claims 1 and 12 above, and further in view of U.S. Patent No. 6,454,819 to Yano et al.
- (7) Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Cherian et al as applied to claim 1 above, and further in view of U.S. Patent No. 6,491,837 to Liu et al.
- (8) Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cherian et al as applied to claim 1 above, and further in view of U.S. Patent No. 5,976,414 to Bedford et al.
- (9) Claims 14-15 and 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cherian et al as applied to claims 1 and 12 above, and further in view of U.S. Patent No. 6,454,819 to Yano et al.

Applicants traverse all of the above obviousness rejections.

Claim 1 has been discussed above. The rejected claims all depend, either directly or indirectly, from claim 1. Each of the obviousness rejections is based on the Examiner's misunderstanding that Li et al and Cherian et al disclose a compound having three azole moieties. Since Li et al and Cherian et al do not disclose a compound having three or more azole moieties, and the remaining references also do not disclose such a compound, the Examiner has not presented a *prima facie* case of obviousness.

The Examiner states, at page 10 of the Office Action, that Bedford et al disclose benzotriazole or mercaptobenzotriazoles having a molecular weight of about 13,000 to about 40,000.

The Examiner, however, has misanalyzed the teachings of Bedford et al. The molecular weight of 13,000 to 40,000 in Bedford et al is not the molecular weight of the benzotriazole or mercaptobenzotriazole, but is the molecular weight of a dispersant or a water soluble anionically charged polymer that is a separate component from the benzotriazole and mercaptobenzotriazole.

Further, Comparative Examples 1, 2, and 4-8 of the present application employed benzotriazole, but did not employ a compound having three or more azole moieties, and did not obtain the results of the present invention. The Examples and Comparative Examples establish that the use of benzotriazole does not achieve the results of the present invention.

In view of the above, Applicants submit that none of the cited references, alone or in combination, teaches or suggests the features of any of the present claims.

Accordingly, Applicants request withdrawal of all of the obviousness rejections.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

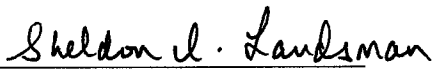
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